REMARKS

Claims 1-9, all the claims pending in the application, stand rejected. Claim 10 previously was cancelled. Claims 2-4 are amended. New claim 11 is added.

Claim Rejections - 35 U.S.C. § 103

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Osamu et al (EP 1145748 A2) in view of Negishi et al (6,571,278). This rejection is traversed for at least the following reasons.

Claim 1

The Examiner substantially repeats the basis for the rejection of this claim that was presented in the Office Action dated April 8, 2008 and the Office Action dated November 10, 2008. The text is virtually <u>identical, except for</u> (1) minor changes in phrasing, (2) the admission at page 6, lines 5-8, that "Osamu et al fails to teach of string both original item data and replica item data in the replication source game data storage means, so that the game can access both the original data and replica data in subsequent game play," and (3) the citation of Negishi et al at page 6 of the office Action for an alleged teaching of storing replica data.

Notably, the Examiner <u>does not address</u> Applicants' arguments with regard to the failure of Osamu, as a matter of U.S. law, to disclose structure that anticipates the structural "means-plus-function" limitations of the claims.

In particular, Applicants respectfully submit that the Examiner's analysis is based upon (1) an incorrect understanding of <u>the legal standards</u> for interpreting "means plus function" limitations, (2) an incorrect interpretation of the several key means plus function limitations in the claim and (3) an unsupported combination of wholly divergent art, one related to game devices (Osamu) and the other related to multi-computer systems like Lotus Notes, where data is shared and replicas are maintained current (Negishi), <u>without any motivation for such combination</u>.

Notably, the Examiner cites a <u>generic teaching</u> of replica updating in paired computers in Negishi et al against a <u>specific structural and functional requirement</u> for specific data in a game

environment to be to be stored, "thereby permitting access to and use of both original item data and the replica item data in subsequent game play."

(1) <u>Incorrect Understanding of Means Plus Function Standards</u>

       <u>Means Plus Function Limitations</u>

Independent claims 1 and 7 define the invention with regard to several limitations that are expressed in "means-plus-function" language. Such limitations are interpreted according to the provisions of 35 U.S.C. § 112, paragraph 6, as acknowledged by the Examiner. However, Applicants would respectfully submit that the Examiner's interpretation of the law applicable to anticipation based on means-plus-function limitations is in error. As specified in MPEP § 2181, the *In re Donaldson Co.* decision (16 F.3d 1189, 29 USPQ 2d 1845, (Fed. Cir. 1994), provides that "the PTO may not disregard the structure disclosed in the specification corresponding to the means-plus-function language when rendering a patentability determination."

In framing the rejections, the Examiner performed an analysis of the claim limitations and properly concluded properly that they are subject to interpretation under 35 U.S.C. § 112, paragraph 6. However, the conclusions with respect to reading of at least the ***replication storage means*** and the ***link storage means*** by the structure in Osamu is not correct.

On the basis of the *Verdegaal* and *Donaldson* decisions, for a prior art to meet a given means-plus-function limitation, it is required that either (1) the corresponding <u>structure</u> disclosed in the specification of the application must be <u>found *identically*</u> in the prior art reference or (2) a <u>structural *equivalent*</u> to such corresponding structure must be found in the prior art reference. In addition, under the basic principles of anticipation as stated in *Verdegaal*, <u>the ***precise function*** specified in a claim must be found, word for word, in the prior art reference</u>.

In order to meet these requirements for each claim limitation, four steps are required:

       First Step - Identify Corresponding Structure <u>in Application;</u>

       Second Step - Determine if Corresponding Structure is <u>Identical</u> in Prior Art;

       Third Step - Determine if Prior Art Structure is an <u>Equivalent</u>; and

       Fourth Step - Determine if Claim <u>Function is Identical</u> in Prior Art.

Identical Function Required

As seen from the required steps above, whether or not the corresponding structure in the prior art is the same or different from the corresponding structure in the specification of the pending application, the structure MUST perform the ***identical function*** for the claim to be met literally by the prior art.

As required by MPEP § 2183, the Examiner MUST find that the prior art element (a) performs the exact function specified in the claim (this means the identical function), (b) is not excluded by any explicit definition provided in the specification for an equivalent, and (c) is an equivalent of the means- (or step-) plus-function limitation.

Factors that will support a conclusion that the prior art structural element is an equivalent to a claim limitation are: (a) the prior art element performs the ***identical*** function specified in the claim in substantially the same way, and (b) produces substantially the same results as the corresponding element disclosed in the specification.

This provision in the MPEP clearly indicates that an ***identical*** function is required for a claim limitation to be met literally. Thus, even though there may be a structural equivalence, the absence of the ***identical*** function would preclude a finding that a claim limitation is anticipated.

As demonstrated subsequently, there is no teaching of an identical function for critical ones of the means-plus function limitations, namely the "***replication storage means***" and the "***link storage means***."

(2) Incorrect Interpretation of Claimed Means Plus Function Limitations

The Invention

By way of background, it is important to note that the invention concerns an improvement to the procedure for saving data in a game apparatus related to a play situation where a game can be resumed later on the basis of the saved data. The process is particularly applicable to the communication between two game machines, where an item acquired in a game space by one player can be assigned to another player or exchanged with another player.

A Replication Problem

A problem exists when a copy of saved data is created in connection with such assignment or exchange without spending a player's own item. In such case, the specified item is stored as saved data (original), a copy of the saved data is created, and when the assignment or exchange is performed on the basis of one of the copy and the original, the game is resumed in a play situation, by using the other saved data, where the item is not spent. Under the circumstances, the <u>replication process causes the number of stored items to **increase** without limit</u>.

Applicant's Solution

The solution to this problem is provided by the present invention and explained in an example at pages 8 and 9. Thus, for a case where the game data of a replication source includes original item data, such that a player character owns N originals of an A item, game data of a replication target will also include replica item data representing that the player character owns N replicas of the A item. In a case where the replication of the game data is executed, <u>link data</u> to correlate the replication target with the replication source is stored into the ROM cartridge 12. Thus, as explained at page 9, where certain items, whether original or replica, are disposed by assignment or exchange, <u>replica items are **decreased**</u>.

Replication Processing Permits Disposal

Details of how this process is conducted, using a storage part 41 with plural data storage parts in a system having replication source determination part 50, replication target determination part 52, replication part 54, uptake part 56 and deletion part 58, as illustrated in Fig. 3, are explained in the application. The content of the storage part 41, including an identification of the <u>number</u> of originals and the <u>number</u> of replicas for each replication source and replication target, is illustrated in Fig. 4 and explained at pages 11-14. Of particular importance to the function of the device, the flowchart in Fig. 5, which is explained at pages 14 and 15, show a replication processing in which an original item included in a game data of a replication source can be included as replicant items in the game data of a replication target. The replication target and replication source are correlated with each other through replication source column 42 and replication target column 44 of Fig. 4. Based on this Table, when a certain item

is disposed of, a related item can also be disposed of. In this way, the number of items are **not increased** due to replication of the game data, as explained at page 15, lines 8-18.

Recording Numbers and Effecting a Decrease In Numbers by Disposal

Importantly, the claimed invention contemplates the existence of plural numbers of a replica, and a record is kept in the storage area 40-1 to 40-3 of that number, as described at page 11 and its use is described at page 12. Further, the process for disposing of an item is illustrated in the routine of Fig. 6 where a decrease in the number of originals and the number of replicas can be effected, thereby keeping the number at a meaningful level. Thus, when disposal of a certain item is instructed, the original of the item is disposed of, and all replicas resulting from the original are disposed of, so that it is possible to prevent the item from increasing due to the replication of the game data, as explained at page 16, lines 24-27.

Specific Summing and Storage Required by Replication Means

These features are represented by the functional limitations in claim 1, particularly the function of the *"replication means,"* which corresponds to the replication part 54 (Fig. 3) as implemented by the CPU 14 executing the game program stored in the ROM cartridge 12, as explained at page 11, first full paragraph. In particular, this structure (1) stores the *game data* into the replication target game data storage means on the basis of the game data stored in the replication source game data storage means so that (2) a sum of the number of original items relating to the original item data stored in the replication source game data storage means and the number of replica items relating to the *replica item data* stored in the replication source game data storage means becomes (3) the number of replica items relating to the replica item data stored in the replication target game data storage means.

In addition, a *link data* is stored to correlate the replication target game data storage means with the replication source game data storage means into a link data storage means, as explained in the specification with regard to the replication source and replication target column data, as illustrated in Fig. 4. This function is not found in the prior art.

Specific Function of the Replication Means

The **stated function** is "*for storing* game data into the replication target game data storage means on the basis of game data stored in the replication source game data storage means."

The claim further specifies that "the replication means *stores* the game data into the replication *target* game storage means on the basis of the game data stored in the replication *source* game data storage means so that *a sum* of the **number of original items** relating to the original item data stored in the replication source game data storage means and the **number of replica items** relating to the replica items data stored in the replication *source* game data storage means becomes the **number of replica items** relating to the replica item data stored in the replication *target* game data storage means."

Finally, the claim specifies that the replication means "*stores the link data* to correlate the replication *target* game data storage means with the replication *source* game data storage means into the **link data storage means**."

Such functional limitations must be interpreted in accordance with the provisions of 35 U.S.C. § 112, paragraph 6. This requirement is acknowledged by the USPTO in MPEP § 2181.

Osamu

Osamu has been discussed in detail in previous reports and amendments and is limited to a video game having a bottle mail function. The Examiner has admitted in connection with previous rejections that Osamu et al does not have multiple game data storage areas for original and replica data, and doe not disclose updating the replica item data stored in another game data storage means relating to item data stored in another game data storage means relating to a replica item as direct or indirect replica of the original item so that the number of replica item is decreased. Indeed, there is no teaching or suggestion at all about decreasing a number of replica items. Thus, the basic goal of the invention, which is to reduce the number of replica items that are stored, cannot be attained by Osamu et al. Moreover, the structures and their expressly recited functions are not taught in Osamu et al.

Identical Function Not Found

At page 9 of the previous amendment, Applicants argued that an **identical function is required for anticipation of a means plus function limitation**. Applicants cited § 2183 of the MPEP in support of this position. There it is stated:

1. "If the Examiner finds that a prior art element
2. (A) performs the functions specified in the claim,
3. (B) is not excluded by any explicit definition provided in the specification for an equivalent, and
4. (C) is an equivalent of the means- (or step-) plus-function limitation,

the Examiner should provide an explanation and rationale in the Office Action as to why the prior art is an equivalent. Factors that will support a conclusion that the prior art element is an equivalent are:

(A)   the prior art element performs the **identical function** specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification…..".

As asserted by Applicants, an **identical function** must be found in the prior art for there to be anticipation, as required by the MPEP and the underlying case law.

Function of Counting Means Of Osamu is NOT Identical

The "counting means" of Osamu as disclosed at col. 4, lines 6-10 and col. 10, lines 13-18 to keep track of exchange items does not teach the entire **identical function** recited for the "replication means." In fact, counting is simply to determine when a game item may be exchanged to other still unpredictable game item. This is counting only one category exchanged through a bottle mail function. Thus, Applicants submit that the Examiner fails to identify any teaching of the precise literal function stated in the claims.

The Examiner's comments to date, including the present Office Action, do not remedy this deficiency by explaining how each and every word in the above repeated function of the replication means is found in Osamu . Indeed, the Examiner merely comments at pages 5 and 6 of the Office Action that :"the counting means **could have been also understood** to keep count of number of copies relative to source game data storage means and **thus used** to keep count of

sum of number of original item relating to the original item data stored in the replication source game data storage means and the number for replica items …".

By this language, the Examiner admits that there is no **identical** teaching of the claimed function. "Substantially teaches" is not identically teaches. "Could have been also understood" is not identically teaches. Indeed, as pointed out by the Applicants the "replication means" is more than simply a counter. At its simplest level, it performs a summing and storage function, neither of which is seen in Osamu et al. Applicants referred to paragraph [0015] of Osamu where the counting means is for (1) counting a number of times where the game item exchange means exchanges game items and (2) determining the at least one exchange object game item based on the number of times.

There is *no mention* in Osamu of a summing operation, whereas a sum of a first number is added to a sum of a second number and becomes a number of replica units, as claimed. Further, there is no teaching or suggestion of calculating with respect to both original items and replica items. Thus, there is no identical function.

No Change of Original Data in the Invention

The replication means also is expressly defined so that it "stores the game data into the replication *target* game data storage means, without changing the original item data and the replica item data stored in the replication *source* game data storage means, on the basis of the game data stored in the replication *source* game data storage means…"

The effect of this functional limitation is understood with regard to the illustration of the game data storage in Fig. 4. There, a replication *source* game data storage means (42-1) is within a first game data storage part 40-1, which is one of several such parts (40-1, 40-2, 40-3) in storage part 41 of the game apparatus 10, as illustrated in Fig. 3. The first game data storage part 40-1 also includes a replication *target* 44-1. A second game data storage part 40-2 similarly contains a replication source 42-2 and a replication target 44-2. The other game data storage parts 40-3, 40-4, etc. would be similarly arranged.

As recited in claim 1, the replication means stores game data into a replication *target* game data storage means (44-1, 44-2, 44-3, etc.) on the basis of game data stored in the replication *source* game data storage means (42-1, 42-2, 42-3, etc.).

As also stated in claim 1 and, as illustrated in Fig. 4, "each of the plural game storage means stores <u>original item data</u> relating to an original item and a <u>replica item data</u> relating to a replica item." This function is explained at page 11, line 26 - page 12, line 23. The use of a *source* storage area and *target* storage area <u>in each game data storage part</u> (40-1, 40-2, 40-3, etc) is to permit storage of (1) <u>original source data</u> and (2) a <u>copy of the original data</u>, the copy being produced by a replication process in order to ensure that a game may resume play by using one of the original or saved data. In other words, the data stored <u>is the same and is not changed</u> when the original item data is stored as replica item data. In short, one is the backup for the other, in the event that an assignment or exchange is performed on the basis of one of the copy and the original, again is resumed in a play situation, by using the other saved data where the item is not spent.

<u>Unique Use of Link Data</u>

The invention solves a problem within this environment, where the original item data and the replica item data are not changed, <u>by using link data</u> that correlates to game data storage means with each other. In particular, as illustrated in Fig. 4, the <u>number of a *source*</u>, illustrated in the left-hand column, is stored and the <u>number of *originals*</u> and <u>number of *replicas*</u>, illustrated in the right-hand column, also is stored for each game data storage part (40-1, 40-2, 40-3, etc.) in storage part 41.

The claimed "replication means" stores both game data and link data. The game data is stored (1) without changing the original item data and the replica item data stored in the replication *source* game data storage means (e.g., 42-1) and (2) stores so that a sum of the number of original items relating to the original item data stored in the replication *source* game data storage means (e.g., 42-1) and the number of replica items relating to the replica item data stored in the replication *source* game data storage means (42-1) becomes the number of replica items relating to the replica item data stored in the replication *target* game data storage means (44-2). The stored link data correlates the *target* game data storage means (44-2) with the replication *source* game data storage means (42-1) in a link data storage means.

Osamu Changes Original Data

The Osamu process relates to video game having a "***bottle mail function***" in which a game player (or character) can exchange his <u>own game item</u> for other <u>unpredictable game items</u> during game play (paragraph [0024]). Where a player wishes to change a game item, an unnecessary <u>own game item</u> is put in a bottle and released, permitting an <u>unpredictable game item</u> to be returned, as explained at paragraph [0025]. This exchange may take place in an item exchange area 44, as illustrated in Fig. 2, and may occur on the basis of a connection between two different game devices 10a, 10b.

As explained at col. 6, lines 36-41, in a first game device, the game item specified by information obtained from the second game device is used as an exchange <u>source game item</u> and an exchange <u>object game item</u> correlated with the exchange source game item is read from an item exchange table. In other words, when a game item is identified in device 10a and released to sea in a bottle, an unpredictable game item specified on the basis of the game item designated in device 10b arrives instead. An item exchange table (Fig. 3), which is stored beforehand correlates an exchange <u>source game item</u> to an exchange <u>object game item</u> and provides a corresponding exchange <u>object game item</u> upon designation of an exchange <u>source game item</u>, as explained at paragraph [0026]. Clearly, the <u>object game item</u> is intentionally made different from the <u>source game item</u> and the item used by a player **is changed**. This is the entire purpose of the Osamu bottle mail function feature.

Clearly, this exchange results in the replacement of data and is distinguishable from the feature in the claimed invention where <u>original item data is not changed</u>.

The Examiner refers to paragraphs [0004] - [0006] as disclosing "allowing the storage medium to store all of the game data without initially modifying it." First, this broad statement does not address the limitations in the claim that require replication means to store the game data into the replication ***target*** game data storage means <u>without changing the original item data</u> and the replica item data stored in the replication ***source*** game data storage means. In other words, the data is simply duplicated. There is <u>no teaching of such duplication function</u> in the cited paragraphs of Osmu et al. Moreover, even an initial storage of game data without modifying it does not meet the claim requirement that a <u>replication would occur</u>; that is, original data is

duplicated. Finally, the Examiner has not pointed to the specific text in the paragraphs of Osamu where the alleged teaching takes place, and Applicants would assert that there is no such teaching. By the Examiner's own inference, <u>immediately</u> after storage in Osamu, there is modification of data. In fact, the selected <u>object game item</u> data is changed into data representing an <u>unpredictable game item</u>.

No Corresponding Structure

Further, as to the second and separate requirement for a <u>corresponding structure</u>, the "counting means" of Osamu et al does not act as a summer of the specified numbers, namely, the number of original items and the number of replica items, and cannot be identical or an equivalent to a summer due to <u>missing arithmetic functions</u>. Further, the counting and determining operations in Osamu for the "time counting means" does not operate to <u>store game data into a replication target game data storage means on the basis of a number of original items and number of replica items</u>.

Thus, there can be no anticipation as there is <u>no identical function</u> and <u>no identical or equivalent corresponding structure</u>.

In the absence of both function and structure, there is no anticipation of the claim limitation nor its structure and function obvious without the use of applicants own teachings.

Link Storage Means

Applicants also submit, as before, that there is no "link data storage means," for storing link data to correlate the replication target game data storage means with the replication source game data storage means. The corresponding structure is the storage part 41, having game storage parts 40-1 to 40-3 and, in particular, the replication source column 42 and the replication target 44, which contain correlating information, as explained in the first full paragraphs on pages 12 and 15 of the original specification.

The Examiner addresses this feature at page 4 of the Office Action and points to a game program in the ROM cartridge 12 as executed by portable game machines in lines 3-7 on page 11 of the application. The Examiner also points to Fig. 1 and the disclosure of a "portable game device, game program [0020] and ROM cartridge [12 in Fig. 1]."

The Examiner states Osamu et al is considered to be an <u>equivalent to</u> Applicants' link data storage means because it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in Applicants' specification.

Again, there is no separate storage structure for both original and replica data in target and source media and, thus, no linking between two correlated storage areas is possible. According, as to the asserted structure in Osama, **the function is not, and cannot be _identical_**. Thus, the analysis fails the statutorily mandated test. The Examiner is simply using broad and indefinite interpretations of specific claim language to assert anticipation. This approach is clearly at odds with the requirements of 35 U.S.C. § 112, paragraph 6 and the guidance provided in the MPEP at § 2183.

Finally, the Examiner previously argued that "if the structure suggested by the prior art is identical to the present invention, then the function may be <u>inherent or intrinsic</u> to the structure, citing MPEP § 2114. However, the simple inclusion of a CPU in both a claim and the prior art does not make all recited functions of a claimed CPU inherent or intrinsic. It is the function that defines over the prior art and cannot be inherent where that recited function is novel and unobvious.

In sum, the additional arguments made in previous amendments have demonstrated that there is <u>no storage of link data</u> by the replication means. Further, Applicants have demonstrated that the corresponding structure for the replication means, which requires a "sum" of two numbers, would not be provided by the counter identified by the Examiner.

Negishi et al

The Examiner points to Negishi et al for a teaching of a data sharing system "which helps to maintain replica consistency, teaches means for storing both original item data and replica item data in the replication source game data storage, such that both the original data and replica data can be accessed [lines 6-24 of column 5 and columns 11 -12]"

Negishi is directed to a **_generic_** <u>computer back up system</u> having two computers A and B where one stores original data and the other stores replica data and are operable on a packet transfer basis. However, there are several fundamental differences between the approach of the

claimed invention and Negishi that preclude the demonstrated and Examiner admitted deficiencies of Osamu from being remedied.

First, contrary to the Examiner's suggestion, there is no teaching that the backup system in Negishi is directed to a game. Thus, the environment and demands for game processings as claimed are not taught in Negisish et al.

Second, there is no teaching or suggestion that multiple replicas can be stored in relation to an original, or that a number of replicas and a number of originals is maintained and stored, as illustrated in Fig. 4 and disclosed at pages 11-15 of the specification.

Third, there is no teaching or suggestion that a link data or a link data storage means exists in the two computers A and B of Negishi, such that there is a correlation as claimed, permitting changes in one storage area to be automatically directed to effect changes in the other correlated storage area.

In sum, the deficiencies of Osamu are not remedied by the generic teachings of Negishi, which fail to address the specifically disclosed and claimed game environment having plural correlated game storage areas of the present invention.

Claims 2-4

These claims would be patentable due to their dependency from claim 1, and for the reasons given with respect to claim 1.

Moreover, with regard to claim 2 (disposal of original item), claim 3 (disposal of replica item), claim 4 (deletion of game data storage means having no replication source), the functional details of these claims is not taught or suggested by Osamu in combination with Negishi. In particular, the claims now are amended to specify that the updating of data stored in two correlated game data storage means, or one of two correlated data storage means is deleted, based on the correlation provided by data in the link data storage means. The link data storage means, as illustrated in Fig. 4 for each game data storage part 40, comprises the related columns storing identification data for the replication source and the replication target, as explained at pages 12 and 15 of the original specification.

Claims Require Means for Updating Stored Data or Storage Means

Claims 2-4 are amended to now expressly claim a means for updating stored original data or replica data, or deleting a game data storage means, on the basis of a correlation provided by link data stored in the link data storage means.

Neither Osamu nor Negishi teach a link data storage means that stores link data correlating a storage for original source data and a storage for replica data, such that a deletion of game data or a game data storage means is automatically changed for another data storage means.

Osamu Deletes Items but does Not Decrease Stored Number

Claims 2-4 each specify that when an item (original – claim 2, or replica – claim 3) is disposed of by an instruction, two correlated storage means are updated such that a number of original items and replica items is decreased. The updating is based on the correlation provided by data in the link data storage means.

Osamu does not teach this feature, as the Examiner admits that there is no two correlated storage means.

Negishi does not teach this feature as there is no link data, or link data storage means that permits a correlation as claimed, such that the reduction in a number of original or replica items in one storage means will reduce a number of corresponding replica or original items in the other storage means. Moreover, as noted above, Negishi does not store a number of each replica item, as only one replica of a packet is contemplated in Negishi.

Claims 5 and 6

With regard to claims 5 and 6, they define the structure of the game data storage means, particularly with respect to the features of the link data storage means that comprising of one or plural memories.

Claims 7-9

These claims are patentable for the reasons given for claim 1.

Claim 11

New claim 11 directly correlates the storage structure of Fig. 4 to the means limitations of claim 1, with particular emphasis on the storage of link data and the storage of numbers of originals and replicas in the correlated storage areas.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Alan J. Kasper/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: August 25, 2009

Alan J. Kasper
Registration No. 25,426